

REMARKS

The Office Action of September 18, 2006 has been carefully considered. Reconsideration of this application, as amended, is respectfully requested.

Turning now, to the office action, the Information Disclosure Statement submitted in March 2002 was objected to as failing to comply with 37 CFR §1.98(a)(2). Claims 3-6, 8, 9, 11-13 and 15-17 were rejected under 35 USC §102(e) as being anticipated by Rivette et al., US Patent 5,991,751 ("Rivette"). Claim 10 was rejected under 35 USC §103(a) as being unpatentable over Rivette, with the Examiner taking Official Notice. Claims 1, 2, 7 and 14 were rejected under 35 USC §103(a) as being unpatentable over Rivette in view of Black et al., US Patent 6,012,042 ("Black").

March 2002 Information Disclosure Statement complies with 37 CFR §1.98(a)(2)

The examiner alleged that the information disclosure statement filed March 22, 2002 failed to comply with 37 CFR 1.98(a)(2) (requiring a legible copy of each cited non-patent literature publication). Upon review of the on-line USPTO file by the undersigned Attorney, it appears that the allegedly missing document by Barker et al., "Web User's Guide to Screening Stock," Business Week, September 22, 1997 No. 3545, pg 114 was indeed submitted by Applicants and can be found beginning at page 3 of the 6-page Non-Patent Literature document bearing a mailroom receipt date of March 22, 2002. Hence, Applicants (i) maintain that a legible copy of the document was included with the Information Disclosure Statement of March 2002, (ii) hereby traverse the Examiner's objection, and (iii) respectfully request that the previously-submitted Business Week document be confirmed as having been previously made of record and considered by the Examiner.

Rejection of claims 3-6, 8, 9, 11-13 and 15-17 under 35 USC §102(e) traversed

Rivette, cited by Applicants, is directed to a system, method, and computer program product for patent-centric and group-oriented data processing, and discloses a system for evaluating the value of a corporation's patent portfolio. Rivette is an example of a prior art system that processes patent information for what is indicated to be a single corporation (e.g., "a corporate entity" col. 3, line 63; "the corporation" col. 4, line 8). However, Rivette does not appear to consider the management of

patent (intellectual property) and non-patent (financial) information from multi-company databases by referencing such information to make a decision.

Instead Rivette indicates that enterprise server 314 is designed for a customer, where the customer is a "customer corporate entity" (col. 15, lines 50-51), that the data is that which "the customer maintains" (col. 16, line 35) for the company, and as described at col. 17, lines 17-20, the patent database 614 is the "customer's repository of patents." While Rivette refers to information about competitor companies, it does not appear to contemplate the searching of multi-company financial and intellectual property databases as is presently recited in the amended independent claims.

Similarly, at col. 21, line 58 – col. 22, line 6, Rivette characterizes the financial databases 638 as storing financial information pertaining to the customer's business. Hence, the financial database of Rivette is not understood to be one that includes data for a plurality of companies.

In light of the amendments made to independent claims 3, 11, 16 and 17, Applicants respectfully submit that the limitations therein are not anticipated by Rivette, and the rejection is respectfully traversed. With regard to the dependent claims, for the sake of brevity and in view of the presumed patentability of the amended independent claims, specific discussion of the dependent claims is not set forth herein. Applicants reserve, however, the right to further set forth arguments in favor of the patentability of the dependent claims should the rejection be maintained.

Rejection of claim 10 under 35 USC §103(a) traversed

The distinctions over Rivette are generally set forth above relative to claim 3, from which claim 10 indirectly depends. Applicants further note that the Examiner's reliance on Official Notice as the basis for filling the gap in the rejection is improper. The Examiner acknowledged that "accessing an assignee/ticker database to determine linkages between the financial database and the intellectual property database on a company basis" was not taught by Rivette (Office Action, p. 9 bottom). Yet the Examiner takes Official Notice that such data is known, and thus obvious to modify Rivette. Applicants respectfully challenge the Official Notice as failing to set forth the limitations found in claim 10, and absent any teaching or suggestion of a modification of Rivette, the rejection is unsupported and respectfully traversed.

In the event the rejection is maintained, Applicants request that the Examiner not only set forth teachings in support of the alleged knowledge (Official Notice) pursuant to MPEP §2144.03, but also the information relied upon by the Examiner to support the assertion that it would have been obvious to modify Rivette to provide the recited method. In other words, even if the Examiner establishes support for the Official Notice taken, such support would not appear to suggest a modification of Rivette, nor would such a teaching set forth the limitations recited in claim 10 (e.g., accessing an assignee/ticker database, determine linkages between the financial database and the intellectual property database on a company basis). Hence, Applicants request that the rejection be withdrawn.

Rejection of claims 1, 2, 7 and 14 under 35 USC §103(a) traversed

Relative to amended claim 1, the distinctions over Rivette are generally characterized above relative to similar claims - with respect to claim 1, Applicants respectfully submit that the additional limitations that the databases include data for a plurality of companies are not taught or suggested by Rivette. Moreover, the rejection indicates that the limitation of "relaxing at least some of the search criteria, until at least a required number of matching records are found, wherein the required number of matching records is never less than one" is taught somewhere between columns 25 and 30 (Office Action p. 11 top). Upon review of the cited section Applicants are unable to identify where such a limitation is taught, and respectfully suggest that the Examiner has failed to establish *prima facie* obviousness by identifying support for the alleged teaching (MPEP §2142 requires that the "the prior art reference (or references when combined) must teach or suggest all the claim limitations"). Applicants respectfully traverse the rejection of amended claim 1, and claim 2 dependent therefrom. In the event the rejection is maintained, Applicants respectfully request that the Examiner set forth with specificity where the recited limitations are alleged to be taught by Rivette or Black.

As to the rejection of claims 7 and 14, Applicants note that these claims are dependent from amended independent claims 3 and 11, respectively and are urged to be patentably distinguishable over Rivette for the reasons set forth above. Moreover, the rejection fails to set forth a basis for teaching of all limitations in the independent claims, and Applicants thereby maintain that the rejection is incomplete on its face. For the sake of brevity Applicants have not set forth further arguments

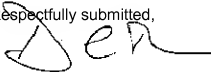
relative to dependent claims 7 and 14, but reserve the right to submit such arguments in the event that the rejections are maintained.

Conclusion

In view of the foregoing remarks and amendments, reconsideration of this application and allowance thereof are earnestly solicited. In the event that additional fees are required as a result of this response, including fees for extensions of time, such fees should be charged to USPTO Deposit Account No. 50-2737 for Basch & Nickerson LLP.

In the event the Examiner considers personal contact advantageous to the timely disposition of this case, the Examiner is hereby authorized to call Applicant's attorney, Duane C. Basch, at Telephone Number (585) 899-3970, Penfield, New York.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D. Basch', with a stylized flourish at the end.

/Duane C. Basch, Esq. Reg. No. 34,545/

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